

REMARKS

Claims 1-6, 8, 10, 15-23 and 25-35 are pending in the application. Claims 1 and 16 are currently amended. Claims 2-6, 8, 10, 15-23 and 25-35 were previously presented, and claims 7, 9, 11-14 and 24 were previously canceled.

No new matter has been introduced by virtue of the amendments made herein. Accordingly, applicants respectfully request their entry. In view of the amendments made herein and the remarks below, applicants respectfully request reconsideration and withdrawal of the rejection set forth in the May 19, 2005 Office Action.

Rejection under 35 USC § 112, First Paragraph

The Examiner maintained the rejection of claims 1-6, 8, 10 and 15-35 under 35 USC § 112, first paragraph, as allegedly containing subject matter which was not described in the specification as set forth in the previous Office Action. In particular, the Examiner indicated that the active ingredients are not defined in the specification and that because of the "lack of direction provided in the specification regarding starting materials, the lack of working examples, and the general unpredictability of chemical reactions, it would take an undue amount of experimentation for one skilled in the art to make the claimed compounds..."

In response, applicants respectfully resubmit that when the present application is viewed in light of the prior art references, which were submitted in response to the Action dated January 11, 2005, the subject matter of the claims is sufficiently described.

Furthermore, without prejudice and solely in the interests of facilitating prosecution, applicants have amended claim 1 to delete the terms "neurotrophic factor," "agent that slows or attests Alzheimer's disease," and "neuronal antiinflammatory agent" and inserted specific examples of a muscarinic agonist, an amyloid aggregation inhibitor, and an estrogen-like agent, all of which were known to the worker of ordinary skill in the relevant art. Support for this amendment is found in the specification and in the cited references (see Hollander E. Davidson M. Mohs RC. Horvath TB. Davis BM. Zemishlany Z. Davis KL. RS 86 in the treatment of Alzheimer's disease: cognitive and biological effects. *Biological Psychiatry*. 22(9):1067-78, 1987 Sep. and Emmerling MR Spiegel K. Watson. Inhibiting the formation of classical C3-convertase on the Alzheimer's beta-amyloid peptide. *Immunopharmacology*, 38(1-2):101-9, 1997 Dec.).

In view of the amendment to claim 1, it is submitted that the active ingredients are defined in the cited references which provide sufficient direction to the skilled worker regarding the starting materials.

Further, in response to the alleged lack of working examples, applicants respectfully point out there is no requirement under MPEP § 2164.02 to have a working example in order to provide enablement. The specification need not contain an example if the invention may be carried out

without undue experimentation. In re Borowski, 422 F. 904, 908, 164 USPQ 642, 645 (CCPA 1970). Thus, applicants submit that, in view of the noted references setting forth the state of the relevant art, the worker of ordinary skill would readily be able to use the specific compounds of any of the aforementioned classes recited in amended claim 1 and formulate them with the active ingredient of instant formula I into the pharmaceutical compositions that include the classes of active ingredients recited in claim 1, as currently amended, using principles and procedures that are common knowledge in the art with the guidance provided by the instant specification and readily available publications. For the foregoing reasons, applicants respectfully submit that the specification is enabling to those skilled in the art.

Accordingly, in view of the amendment made herein and the remarks above, applicants respectfully submit that claims 1-6, 8, 10 and 15-23 and 25-35 are patentable under 35 USC § 112, first paragraph, and therefore request that the Examiner withdraw the rejection.

Rejection under 35 USC § 112, Second Paragraph


In paragraphs 4 and 5 of the office action, the Examiner rejected claim 16 under 35 USC § 112, second paragraph, because the amended term "N-[10-azatricyclo[6.3.1.0^{2,7}]dodeca-2(7),3,5-trien-4-yl]acetamida" lacks antecedent basis, is vague, and indefinite.

In response applicants note that "acetamide" was mistakenly misspelled as "acetamida" in the amendment. However, solely in the interests of facilitating prosecution, applicants have amended claim 16 to delete said compound, without prejudice.

In view of the amendments set forth herein and remarks above, applicants respectfully submit that the pending claims are fully allowable, and solicit the issuance of a notice to such effect. If a telephone interview is deemed to be helpful to expedite the prosecution of the subject application, the Examiner is invited to contact applicants' undersigned attorney at the telephone number provided.

The Commissioner is hereby authorized to charge any fees required under 37 C.F.R. §§1.16 and 1.17 or to credit any overpayment to Deposit Account No. 16-1445.

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